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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,767	07/18/2000	Matthew W. Milne	K35A0617	8826
26332	7590	01/04/2005	EXAMINER	
WESTERN DIGITAL CORP. 20511 LAKE FOREST DRIVE C205 - INTELLECTUAL PROPERTY DEPARTMENT LAKE FOREST, CA 92630			EL HADY, NABIL M	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/618,767	Applicant(s) MILNE ET AL.	
	Examiner Nabil M El-Hady	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/30/04 & 7/30/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. Claims 1-19 are pending in this application.
2. The disclosure is objected to because of the following informalities: amendment to the specification filed on 4/30/2004 contain pending application numbers that does not match the disclosed titles when compared with the PALM system . Appropriate correction is required.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending recently allowed U.S. Application No. 09/618,765, hereafter "765". Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and "765" are claiming methods for establishing a connection between a personal computer system and a content- delivery server by providing a network address and a server-contacting program in a disk drive and installing firmware in the disk drive to initiate execution of the server contacting program after connecting the disk drive to the personal computer or upon the occurrence of selected conditions. A combination of limitations in claims 1-19 in the instant application are similar and obvious to a combination of limitations in claims 1-20 in "765".

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5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4, 6-8, 11, 12, 14-16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Welder (US 6,473,855).

7. As to claims 1 and 2, Welder discloses the invention as claimed including a method of manufacturing and delivering a disk drive for establishing a connection between a content delivery server and a personal computer system that includes a computing subsystem and a disk drive (inherent in abstract; and Figs 1 and 2), the method comprising: identifying a network address for the content delivery server (col. 9, lines 13-26); providing a server-contacting program (col. 3, lines 43-58); storing the network address and the server-contacting program in the disk drive (col. 4, lines 13-29); and installing firmware having disk drive executable code ; and col. 8, lines 11-31) to initiate execution of the server- contacting program after the disk drive is connected to the computing subsystem in the personal computer system (col. 7, lines 45-55; and col. 8, lines 11-31); wherein execution of the server contacting program includes using the network address for connecting the personal computer system to the content delivery server (col. 9, lines 6-37).

8. As to claim 11, the claim is rejected for the same reasons as claim 1 above. In addition, Welder discloses a disk drive (Fig. 2) comprising a network address for identifying a content delivery server and a server contacting program (col. 3, lines 43-58; col. 4, lines 13-29; and col. 9, lines 13-26); and a disk controller circuit having disk drive executable code that initiates execution of the server contacting- program (col. 7, lines 45-55; and col. 8, lines 11-31) upon

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the occurrence of a selected condition that is determined by the disk controller circuit (col. 11, lines 20-46; and col. 2, lines 26-31) and after the disc drive is connected to a computing subsystem in a personal computer system (col. 3, lines 55-58; and col. 8, lines 52-58); wherein execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server (col. 9, lines 6-37; and col. 3, lines 43-58).

9. As to claims 3 and 12, Welder discloses the disk drive includes a protected area; and the network address and the server-contacting program are stored in the protected area (col. 7, lines 46-64).

10. As to claim 4, Welder discloses the firmware automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system (col. 3, lines 55-58; and col. 8, lines 52-58)..

11. As to claims 6,7,14, and 15, Welder discloses the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a selected number of monitored events exceeds a threshold is determined or upon the occurrence of a selected condition (col. 11, lines 20-46), the monitored events includes the number of boot-ups in the computing subsystem (col. 2, lines 26-31).

12. A to claims 8 and 16, Welder discloses the personal computer system receives content data from the content delivery server (col. 10, lines 12-15; and col. 15, lines 47-56) and subsequently displays the content during a boot sequence (abstract).

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13. As to claim 19, the claim is rejected for the same reasons as claims 1, 6, 11, and 14 above. In addition, Welder discloses in the disk drive a non-protected area and a protected area (inherent in col. 7, lines 46-64), comprising at least one application program and an installation program for installing the application program in the non-protected area (inherent in col. 4, lines 13-30); and disk drive executable code for, upon the occurrence of a selected condition determined by the firmware, initiating the loading and execution of the installation program which thereafter installs the application program in the non-protected area (col. 3, lines 55-58; col. 8, lines 52-58; and col. 11, lines 20-46).

14. Claims 5, 9, 10, 13, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welder (US 6,473,855) as applied to claims 1-4, 6-8, 11-14, and 16-18 above, and further in view of Peterson et al. (US 6,594,682), hereafter "Peterson".

15. As to claims 5 and 13, Welder does not specifically disclose the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a predetermined period has lapsed. Peterson, on the other hand, discloses the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a predetermined period has lapsed (abstract). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Welder and Peterson because Peterson's teaching would enhance the performance of Welder's system by allowing execution to take place at pre-scheduled times.

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16. As to claims 9 and 17, Welder does not specifically disclose the content of the displayed content data is periodically changed. Peterson, on the other hand, discloses changing the content is periodically. It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Welder and Peterson because Peterson's teaching of changing the content would provide content updating customized for the user of Welder's personal computer system.

17. As to claims 10 and 18, Welder discloses the content data is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data (inherent in col. 2, lines 51-55).

18. Applicant's arguments filed 4/30/2004 have been fully considered but they are not persuasive. Therefore, rejection of claims 1-19 is maintained.

19. In the remarks, applicants argued in substance that (1), Welder fails to teach a disk drive executable code. Examiner respectfully traverses applicants' remarks.

20. As to point (1), Welder clearly discloses a disk drive executable code (col. 8, lines 11-31, 52-54) as interpreted by the examiner. In addition, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the code is intended to be executed on the disk drive itself rather than being loaded for execution by the computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 20, 2004

A handwritten signature in black ink, appearing to read 'N. El-Hady', with a long, sweeping diagonal line extending from the bottom right of the signature.

Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
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